

### **REMARKS/ARGUMENTS**

This patent application presently includes claims 1-41, all of which stand rejected. The claims are amended to define the Applicant's invention more clearly, and all rejections are respectfully traversed.

This amendment follows the filing of a Request for Continued Examination ("RCE"), accompanied by an Information Disclosure Statement ("IDS"). Accordingly, any future Office Action must take into consideration that IDS and the present Amendment and Arguments.

Claims 1-17 and 35-41 were rejected as anticipated by Weiss, et al., U.S. Patent No. 5,270,909. This rejection is respectfully traversed. Weiss does not teach or suggest the present invention.

In making the rejection the Examiner refers to a flashlight embodiment in Weiss and specifically takes the position that a battery is a tool. This is indeed far fetched, and those skilled in the art would never consider a battery to be a tool. Nevertheless, in order to narrow the issues in this application, amendments have been made to the claims. Specifically, claims 1 and 35 now recite that the tool extends through the opening when the tool assembly is in condition to be used as a tool. If a flashlight is to be used (and assuming, for the purposes of argument, that it could possibly be considered a tool), it is clear that the flashlight could ever be used if a portion of a battery extends from the body portion through the opening.

In addition, claims 1 and 35 now recite that the carabiner assembly is constructed and positioned so that the tool extends in a direction away from a body to which the carabiner attachment is attached when the tool is withdrawn from the chamber through the opening. There is not the slightest teaching or suggestion of such a feature in Weiss. Moreover, this feature provides a specific advantage for a tool, in that it may be used while the carabiner is attached to a

body. For example, the tape measure may be withdrawn and used while its carabiner is still attached to a carrying hook.

In view of the foregoing, it is believed that claims 1-17 and 35-41 distinguish patentably over Weiss, that the rejection should thereof be withdrawn, and that these claims should be allowed.

Claims 1-41 were rejected as obvious over Brown, Jr., U.S. Patent No. 5,553,340, or Jones, U.S. Patent No. 5,815,873, or Lin, U.S. Patent No. 6,098,226, in view of Weiss, Barber, U.S. Patent No. 6,223,372 or admissions in the present patent application. This rejection is respectfully traversed. None of the references, nor any combination thereof renders the present claims obvious.

First of all, the primary references, Brown, Jones and Lin do not teach or suggest the use of a carabiner. Weiss and Barber do disclose the use of carabiners, and the present application states that carabiners have been used in many applications and nothing more of consequence. However, none of the references teach or suggest the use of a carabiner in the claimed type of structure. Moreover, with respect to claims 1-17 and 35-41, above, it has been shown that this claimed structure achieves additional functionality. Thus, if it were obvious to provide the claimed structure, it certainly would have been done in the prior art, in view of the additional functionality and benefits to be derived. The fact that the Examiner had to resort to the far fetched combinations presented in the Office Action is therefore evidence of the fact that the claimed subject matter is not obvious.

Should the Examiner persist in rejecting the claims, it is requested that he demonstrate specifically where in the prior art he finds the slightest suggestion of longitudinal movement of a tool through the opening and of the relative positioning of the opening and carabiner.

As for claims 18 and 25, they, too, incorporate the lengthwise movement of the tool and the relative positioning of the carabiner and opening. Accordingly, claims 1, 18, 25 and 35 are believed to distinguish patentably over all references of record or any combination thereof and should be allowed. The remaining claims depend from one of these claims and are allowable based on the allowability of the respective independent claim.

The undersigned feels compelled to object to the Examiner's entire approach to making the obviousness rejections in the present instance. In the Office Action, the Examiner has improperly selectively combined disclosures from multiple references to make the present rejections. Basically, the examiner has looked at the disclosure of the present application and has used it to arbitrarily select features from the cited references to make the rejection. Apparently, the examiner has overlooked the requirement that for references to be combined, "there must be some reason, suggestion or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge cannot come from the applicants' invention itself." *In Re Oetiker*, 24 U.S.P.Q. 2d 1443 (Fed. Cir. 1992). "The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 23 U.S.P.Q. 2nd 1780, 1783 (Fed Cir. 1992).

It is error to reconstruct the patentee's claimed invention from prior art by using the patentee's claim as a "blueprint" when prior art references require selective combination to render obvious a subsequent invention. There must be some reason for the combination other than the hindsight obtained from the invention itself. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132 (Fed. Cir. 1985).

Indeed, the only disclosure for the combinations made by the examiner (which, nevertheless, do not lead to the present invention) is the present patent application itself. As stated by the CAFC in *In Re Fritch*, 23 USPQ 2d. 1780 (Fed. Cir. 1992):

[I]t is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious... This court has previously stated that "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

The CAFC has also stated that:

As in all determination under 35 U.S.C. §103, the decision maker must bring judgment to bear. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps.

*In Re Gorman*, 18 USPQ 2d. 1885 (Fed. Cir. 1991).

It might very well be asked how the present invention could be considered obvious, since, as explained above, there are substantial benefits derived from the invention and none of the references even suggests it.

We do not pick or choose among the individual elements of assorted prior art references to recreate the claimed invention, but rather, we look for some teaching or suggestion in the references to support their use in the particular claimed combination.

*Symbol Technologies, Inc. v. Opticon, Inc.*, 19 USPQ 2d. 1241 (Fed. Cir. 1991). It is by now well settled that obviousness cannot be established by combining the teachings of prior art references to produce a claimed invention, absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montifore Hospital*, 221 USPQ 929 (Fed. Cir. 1984).

In summary, the examiner has no basis for making the combination he suggests, and even if that combination were made, it would not lead to the present invention.

## **RESPONSE TO EXAMINER'S ARGUMENTS**

In the last Office Action, the Examiner argued that “such that said tool extends from said body portion” is functional and considered to be met by the prior art if it is capable of performing that function. First of all, the limitation is *not* functional. In fact, the “such that” clause specifically defines the size of the opening further. It is therefore a *structural limitation*. Furthermore, the only reference cited by the Examiner for the tool extending from the body portion was the flashlight embodiment of Weiss. As presently amended, claims 1 and 35 provide that the tool extends through the opening when the assembly is in a condition to be used as a tool. Clearly, that function is not possible with the flashlight. This assumes for purposes of argument that a flashlight could be considered a tool, since its only function is to illuminate. With the battery protruding from the opening, that function is impossible. Accordingly, even under the Examiner’s assumption that this is a functional limitation, it is clearly not met by cited art.

Applicant’s attorney has made every effort to place this patent application in condition for allowance. It is therefore earnestly requested that this application, as a whole, receive favorable reconsideration and that all of the claims be allowed as presently constituted. Should there remain any unanswered questions, the Examiner is requested to call the Applicant’s undersigned attorney at the telephone number indicated below.

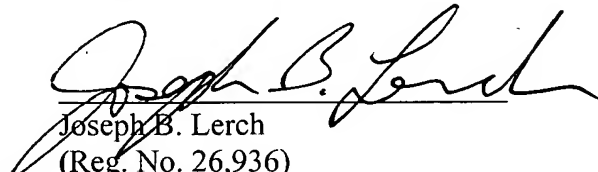
Applicant does not believe any additional fees are required with this Amendment. However, should the Examiner for some reason feel otherwise, the Commissioner is authorized to deduct such additional fees from our Deposit Account No. 11-0223, with applicant reserving herein its right to later object to such fees.

The Commissioner is hereby authorized to deduct any fees believed due from, or credit any overpayment to our Deposit Account No. 11-0223.

Respectfully submitted,

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